

*Indel* ( a teething element that is attached to at least one of said leaves, said teething element being fabricated from a non-toxic material and being sized and dimensioned to be comfortably inserted into an infant's mouth for teething purposes, said teething element further having no sharp edges capable of injuring an infant, whereby it will be safe for an infant or small child to place his or her mouth on said teething element.

*A1* 2. (Amended) A teething toy according to claim 1, [wherein] further comprising artwork that is provided on at least one of said leaves.

*Indel* ( 3. (Amended) A teething toy according to claim 2, wherein said teething element is integrated into said artwork so [as to accentuate said artwork] that said teething element appears to be part of said artwork.

*A2* 6. (Amended) A teething toy according to claim 1, wherein at least one of said leaves comprises a [cloth-like] cloth material.

13. (Amended) A teething toy according to claim 12, wherein said teething element is [sufficiently] weighted to keep the book-like structure from closing when it is laid open.

*A3* 14. (Amended) A book-like article for small children, comprising:

a plurality of leaves;

binding means for binding said leaves together as a book; and

gripping means, secured near an outer edge of at least one of said leaves, for providing enhanced grippability to the leaf, said gripping means comprising teething means for permitting an infant to safely teethe thereon, said teething means being fabricated from a nontoxic material and being sized and dimensioned to be comfortably inserted into an infant's mouth for teething

Q3 purposes and further having no sharp edges capable of injuring an infant, whereby a small child will be able to teethe and to easily turn the leaves of the book-like article like a book.

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18. (Amended) A book-like article for small children, comprising:

a plurality of leaves;

binding means for binding said leaves together as a book; and

Q4 leaf weight means, secured near an outer edge of at least one of said leaves, for providing enhanced weight to the outer edge area of the leaf, said leaf weight means comprising teething means for permitting an infant to safely teethe thereon, said teething means being fabricated from a nontoxic material and being sized and dimensioned to be comfortably inserted into an infant's mouth for teething purposes and further having no sharp edges capable of injuring an infant, whereby the book-like article will function as a teether and be discouraged from closing when it is laid open in a given position. *Such*

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Kindly enter new claims 22-36, which read as follows:

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22. A teething toy according to claim 1, wherein said teether element is fabricated from a nontoxic resilient elastomeric material.

Q5 23. A teething toy according to claim 22, wherein said teether element has a textured surface thereon for facilitating teething.

24. A teething toy according to claim 14, wherein said teething means is fabricated from a nontoxic resilient elastomeric material.

25. A teething toy according to claim 24, wherein said teething means has a textured surface thereon for facilitating teething.

26. A teething toy, comprising:

a book-like structure having a plurality of leaves, said leaves being fabricated from a material comprising cloth; and

*modified*  
teething means attached to at least one of said leaves, said teething means being fabricated from a non-toxic resilient elastomeric material and being sized and dimensioned to be comfortably inserted into an infant's mouth for teething purposes, said teething means further having no sharp edges capable of injuring an infant, whereby it will be safe for an infant or small child to place his or her mouth on said teething means.

*9th - repeats 26*  
*(12)* 27. A teething toy according to claim 26, wherein said teething means is fabricated from a nontoxic resilient elastomeric material.

*Q5.* 28. A teething toy according to claim 27, wherein said teething means has a textured surface thereon for facilitating teething.

29. A teething toy according to claim 26, wherein further comprising artwork that is provided on at least one of said leaves.

30. A teething toy according to claim 29, wherein said teething means is integrated into said artwork so that said teething means appears to be part of said artwork.

31. A teething toy according to claim 26, wherein a plurality of said teething means are provided.

32. A teething toy according to claim 26, wherein said teething means is textured so as to provide teething relief to an infant or small child when chewed on.

33. A teething toy according to claim 26, wherein said teething means is sized and configured so as not to be capable of entering and penetrating to its full depth an opening in a test fixture that is 30 mm in depth, 35 mm in height, and 50 mm in width, with the ends of the width being curved at a radius of 17.5 mm.

AS 34. A teething toy according to claim 26, wherein said teething means is sized and configured so as not to enter and penetrate to its full depth a cylindrical cavity in a test fixture that has a depth of 30 mm, and a circular opening having a diameter of 42.7 mm

35. A teething toy according to claim 26, wherein said teething means is secured to one of said leaves by a tether.

36. A teething toy according to claim 26, wherein said leaves comprise an inner foam core.

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#### REMARKS

This amendment is submitted in response to the Office Action dated May 11, 2000. After entry of this amendment, claims 1-14, 16-18 and 20-36 will be pending. Reconsideration and allowance is respectfully requested in view of the remarks made below.

**1. *The Information Disclosure Statement***

The undersigned was surprised to note that the cover sheet of the Office Action did not include a copy of the Form PTO-1449 that was attached to the Information Disclosure Statement filed on February 14, 2000. The undersigned assumes that the Information Disclosure Statement has in fact been considered, and that the failure to attach the form PTO-1449 to the Office action was an oversight. If, however, the Information Disclosure Statement failed to make its way to the Examiner, the undersigned would be happy to forward a copy by facsimile including, of course, a copy of the stamped postcard proving that it was received in the mailroom of the Patent and Trademark Office well before the mailing date of the Office action.

**2.     *The Formal Rejections***

Claims 3 and 13 were rejected under §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, it was felt that the phrase "integrated into said artwork" in claim 3 was vague and indefinite. It was also felt that the phrase "sufficiently weighted" in claim 13 was indefinite.

In response to these rejections, Applicant has amended claims 3 and 13. Applicant respectfully submits that the amended claims comply with the statutory requirements of clarity and definiteness. Withdrawal of the section 112, second paragraph rejections is respectfully requested.

**3.     *The Prior Art Rejections***

Original claims 1-8 and 12-21 were rejected under §102(b) based on U.S. patent 5,217,256 to Lomas ("Lomas"). Claims 9 and 10 were rejected under section 103 also based on Lomas. Claims 1 and 11 were rejected under §102(b) based on U.S. patent 5,626,366 to Lee ("Lee"). Applicant respectfully but strenuously traverses all of these rejections, and urges that it

would be improper to apply rejections of this nature to the claims as amended, for the reasons set forth below.

Applicant has invented a teething toy for infants and very young children that is entirely different in its nature, purpose, construction and audience than the articles that are disclosed in the Lomas patent and the Lee patent.

As Applicant sets forth in amended claim 1, the invention may include a book-like structure having a plurality of leaves, and a teething element that is attached to at least one of the leaves. The teething element is fabricated from a non-toxic material and is sized and dimensioned to be comfortably inserted into an infant's mouth for teething purposes. The teething element further has no sharp edges capable of injuring an infant, whereby it will be safe for an infant or small child to place his or her mouth on said teething element. All of the independent claims now pending recite a teething element or teething means having these characteristics.

The Lomas patent discloses a paper stack protection device that has a triangular shaped pocket that is designed to accept a corner of a stack of papers. A staple through the pocket and the corner of a paper stack secures the pocket to the stack of papers. The top and bottom sides of the pocket provide a long foldback line along the hypotenuse of the front and back sides of the pocket so that the first and last sheets of the stack of papers are inhibited from tearing away from the stack.

Clearly, the paper stack protection device that is disclosed in the Lomas patent is completely unrelated to Applicant's invention, and has nothing to do whatsoever with children's products or with teething devices. This seemed to be recognized by the Examiner in the Office action, but the position was taken that the "intended use of the element for teething is not attributed any patentable weight in the context of an article claim." Applicant respectfully submits that this position is legally incorrect, and that the rejection should be withdrawn for that reason. The undersigned knows that there exists a preference on the part of many examiners for

the use of structural limitations in article and in apparatus claims, and that functional limitations are frequently ignored or given reduced importance unless they are expressed in means plus function format. However, the courts have repeatedly held over the past several decades that this practice is wrong, and rejections based on such theories have been overturned with regularity on appeal. This is apparent from the opinion of the Court of Appeals for the Federal Circuit in *In re Schreiber*, 128 F.3d 1473, 44 U.S.P.Q.2D 1429, 1997 (1997), in which Judge Bryson wrote:

A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 58 C.C.P.A. 1027, 439 F.2d 210, 212, 169 U.S.P.Q. (BNA) 226, 228 (CCPA 1971) ("There is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.").

Accordingly, the complete lack of consideration given to the recited function of the teether elements in the originally presented claims in determining the patentability or lack thereof of those claims is simply inconsistent with established case law. The original rejections should fail on this ground alone.

In addition, applicant's claims contain a number of structural limitations that are not disclosed or suggested in any of the references of record. The term "teething element" or "teething means" in Applicant's claims is itself a structural recitation, not a functional statement. There is absolutely no disclosure or suggestion in any of the cited references of anything approximating a teether element that is fabricated from a non-toxic material and is sized and dimensioned to be comfortably inserted into an infant's mouth for teething purposes. There is furthermore absolutely no disclosure or suggestion of such a teether element that has no sharp edges capable of injuring an infant, whereby it will be safe for an infant or small child to place his or her mouth on said teething element. On the contrary, the Lomas device is presumably fabricated from a dyed paper material that would be unsafe for an infant to chew on, and further has a large staple protruding from it. It is probably safe to presume that most parents would not want their infants chewing

on the paper stack protection device disclosed in Lomas. The book cover corner guard disclosed in Lee is not much better from a child safety perspective. It has a sharp edge, as may clearly be seen on the front page of the patent, and may be constructed of a number of materials, including sheet metal. There is absolutely no disclosure or suggestion provided anywhere in the specification of this patent that one consideration in the design of the corner guard is the safety of an infant that might chew on the corner guard. In fact, given that the purpose of the device is to protect the corner of a book, it is probably a safe assumption that the intent is to keep the book itself and the corner guard away from anything that could damage the cover of a book. Infants would certainly qualify as a danger to a nice book cover, as any parent can attest.


For the reasons set forth above, applicant respectfully submits that the rejection that was applied to the original claims was improper, and should not be repeated. Withdrawal of the rejections and an indication of allowability for the claims now pending is respectfully solicited.



4. *Conclusion*

Applicant has made an earnest effort to place this application in condition for allowance. If the Examiner feels that a telephone interview would expedite prosecution of this patent application, he is respectfully invited to telephone the undersigned at 215-599-0600.

Respectfully submitted,

  
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